

Remarks

The paragraphs of the Office action are responded to through the corresponding numbered paragraphs below. The applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

Initial Matters: The Previous Rejection

1. The Examiner has stated "Applicant's arguments with respect to claim 1-18 [sic] have been considered but are moot in view of the new grounds(s) of rejection."

Applicant is puzzled by this statement. If the Examiner feels that the grounds for the previous rejection were proper, then it is hard to see how any new grounds or prior art would moot those original grounds for rejection. If, instead, the Examiner, after reviewing the arguments set forth in Applicant's response filed on December 23, 2003, now feels that the arguments are persuasive and has withdrawn the previous rejection but entered new grounds for rejection, it appears that the proper response by the Examiner should have been Form Paragraph 7.38.02, "Arguments Persuasive, New Ground(s) of Rejection":

Applicant's arguments, see [1], filed [2], with respect to the rejection(s) of claim(s) [3] under [4] have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of [5].

Applicants respectfully request that the Examiner clarify this matter for the record.

Claim Rejections – 35 USC § 102

2. The Examiner provided the citation to "35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action." The applicant believes that no specific response is required for this paragraph.

3. The Examiner rejected claims 1-3 and 19-20 "under 35 U.S.C. 102(a) as being anticipated by Krause U.S. Patent no. 5,526,520." Applicant has carefully read the cited reference and is not able to find any description of Applicant's invention as claimed in the pending claims. In particular the elements of Applicant's claims include quoted passages and the highlighting of such quoted passages, while Krause discloses, according to the Examiner's own description, "a method operating on a digital computer to organize and manipulate blueprint documents using hypermedia links from a primary documents [sic] to recall related secondary documents."

No prima facie case has been presented

The Examiner has not presented a prima facie case of unpatentability for any claim. Instead, he has simply repeated the elements of each claim and asserted that they are all contained in the cited reference. The Examiner provides no evidence of where those claim elements can be found in the cited references, other than a broad range of pages and figures. Mere assertions that a reference anticipates a claim, without indicating what in particular in the reference corresponds to the elements of that claim, are not evidence capable of making a prima facie case of unpatentability.

Since the Examiner has not make a prima facie case of unpatentability in the office action, Applicant is entitled to a patent on the invention as claimed and respectfully request that the Examiner withdraw his rejection and allow all pending claims.

Krause does not disclose key elements of the claims

Moreover, as noted above, the cited reference does not disclose the elements of the claims. The specification contains particular definitions for a number of the key terms that differentiate the claimed invention over the prior art – in particular, “quotation,” “source document,” and “reference document”:

A reference document is a document that contains a quotation of a passage of a source document. . . .

A quotation of a passage from a source document means that that passage has been copied from the source document, or another document that itself quoted the source document, when the reference document was created. Such copying could be by copying the passage from the source document using a word processor and then pasting it into the reference document. Alternatively, the passage from the source document could be retyped as the reference document was being written. In either case, access to the source document, or another document quoting from the source document, during the creation of the reference document is necessary and the quotation represents a literal copying of a portion of the source document, the quoted passage. Something is not a quotation simply because it contains some words in common with another document.

As an example, this response is a reference document containing the above quotation from the application, which is the source document. Similar examples are contained in the pending application and in the prosecution history of the parent application.

The Examiner has not shown where the Krause reference discloses a reference document that contains a quotation of a passage of a source document, nor can he because neither references disclose any document that contains a quotation from any other document, as that term is defined in the specification.

Krause discloses, by the Examiner's own admission, only a technique where hypermedia links from a primary documents are used to recall related secondary documents. Those secondary documents are, for example, "detailed drawings of the primary document including sectional or end views" or similar items as would be common in architectural and engineering drawings. The hypertext links are not quotations, as in Applicant's claimed invention, but links "visually indicated on the primary document with a name which indicates the file of the secondary document."

But of more importance, there is nothing in Krause indicating that following the display of Krause's secondary document, any highlighting takes place, much less the highlighting of the quoted passage required by Applicant's claim 1 and rest of the claims, that all depend on that claim.

Applicant's terminology must be considered

It is black-letter patent law that an Applicant can be his own lexicographer. The many court cases on this point are summarized in MPEP's section 608.01(o)'s statement that "A term used in the claims may be given a special meaning in the description." In construing a claim to determine whether a "prior art" reference discloses an element of that claim, the Examiner must use the special mean of a term if it is clear that such a special meaning is intended by Applicant. As seen from the language of the specification quoted above (for example, "A reference document is a document that contains a quotation of a passage of a source document."), it is clear that Applicant intended special meanings for certain terms in the claims and those special meanings must be used by the Examiner.

This is not importing limitations from the specification into claims, as might be the case when the description of the preferred embodiment is used to limit the scope of a claim element. Nor is the Examiner allowed to give a claim element its broadest possible interpretation when that interpretation ignores the special meaning given to a term in the claim.

The only qualification of that right of Applicants to define the terms in a claim as they wish is that "No term may be given a meaning repugnant to the usual meaning of the term." The Examiner has not shown in any way that the definitions of "reference document," "source document," "quotation," or "quoted passage" are in any way

repugnant to the usual meaning of the terms. Applicants have defined claim terms in particular ways in the specification, and the Examiner is not free to ignore or distort those special meanings.

The Examiner ignores the claim limitation of dynamic highlighting

Another aspect of the invention is that:

The highlighting of a quoted passage in a source document using the techniques of the present invention is inherently dynamic. It is not a static highlighting determined at the time the source document is formatted for the hypertext system, as is the case for the highlighting of a hypertext link, but instead is based on the particular quotation selected by the user. If there are different quotations from the source document, the highlighting will be different depending on the particular quotation selected by the user.

This aspect of the invention is expressed in the claims by the element "where the highlighting of the quoted passage is based on the result of the location step and not highlighting previously in the source document" as well as the specified ordering of the elements of the claimed method as indicated by the connective "and then" which requires the completion of one element of the claim before moving on to the next. Note, in particular, that the "locating step" must occur after the display of the reference document, the selection of the quotation by the user, and the retrieval of the source document containing the quoted passage. And it is not until after the locating step that the claimed highlighting can come into existence.

Note that highlighting that is already present in the source document can never be prior art for the claim limitation, which excludes by its clear language "not highlighting previously in the source document."

The Examiner improperly ignores this important claim limitation. There is no place in the portion of Krause cited by the Examiner (Col. 4, lines 15-65) where "highlighting of a quoted passage" not "previously in the source document" is discussed, no matter how the Examiner may choose to interpret "quoted passage" and "source document."

It is not clear what highlighting in Krause the Examiner feels corresponds to the claimed highlighting, since he has given no indication beyond a general assertion that the claimed highlighting is disclosed in both those references. But there is no such highlighting in the reference.

The Examiner has not considered the invention as claimed

That the Examiner fails to recognize what is being claimed, and because of that continues to mischaracterize the claimed invention, is amply illustrated by his reason for rejecting claims 19 and 20. As stated by Applicant when these claims were added:

Applicants feel that these new claims simply restate what is stated in claim 1 when interpreted in light of the definitions in the specification. They are being presented for examination simply to better frame the issue of whether terms of claim 1 should be given a broader meaning than their definition in the specification, and to make it clear that any prior art must teach the presence of a true quotation from a source document.

Claim 19 reads:

The method of claim 1, wherein said quotation has been copied from said source document, or another document that itself quoted said source document, when said reference document was created.

It is clearly not a claim for an additional step in the method of claim 1. Instead, as Applicant noted, it restates the limitation on what a "quotation" is in the context of this invention, copying the definition of the term from the specification (as discussed above). Yet the Examiner simply says that Krause discloses such a "quotation" because by "providing a mechanism for copying (Krause Col. 6, lines 46-59.)"

Claim 20 reads:

The method of claim 19 where said copying was performed as said reference document was being written by retyping said quoted passage into said reference document or by selecting said quoted passage from said source document and then inserting said selected passage into said reference document using a word processor.

This further defines what a "quotation" is, by requiring that it be copied (by retyping or by copy-and-paste in a word processor) from a source document at the time the reference document is created. As discussed previously, "quotation," "quoted passage," "source document," and "reference document" all have specific meanings in the context of this invention. Yet again, the Examiner ignores those definitions and says that claim 20 is disclosed by Krause Col. 6, lines 46-59.

Here is what that portion of Krause discloses:

The PAGE function when activated pulls up a menu which includes the following subfunctions: CREATE, LOAD, CLOSE, MAKE COPY, PRINT, PLOT, DESCRIBE, QUIT. The CREATE function will create a new file for a

page. The LOAD function will load the page file which is input by the operator as the document displayed on the screen 14. The MAKE COPY will copy an existing page file and provide a new name for the new copy to be input for the project. The PRINT and PLOT functions will output the page file on the display 14 to the printer 22 or other external. The QUIT function puts the user back to the previous display screen. The DESCRIBE function pulls up textual information regarding a description of the job or project and files associated therewith, and allows same to be modified.

Nothing is disclosed about quotations and quoted passages, and reference and source documents. All Krause discloses regarding copying in the portion cited by the Examiner is that "The MAKE COPY will copy an existing page file and provide a new name for the new copy to be input for the project." Krause doesn't even disclose that a portion of a file may be copied by his invention. It is only with clear (and impermissible) hindsight that such a sentence can be said to even attempt to disclose the invention of claims 19 and 20.

Applicant is entitled to a patent on the invention as claimed

Since the "prior art" cited by the Examiner in the office action does not anticipate the claimed invention because it does not disclose key elements of each claim, Applicant entitled to a patent on the invention as claimed and respectfully request that the Examiner withdraw his rejection and allow all pending claims.

Claim Rejections – 35 USC § 103

4. The Examiner provided the citation to "35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action." The applicant believes that no specific response is required for this paragraph.

5. The Examiner noted that the application currently names joint inventors and that "the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The applicant confirms that the examiner's presumption is correct to the applicants best knowledge.

6. The Examiner rejected claims 4-18 "under 35 U.S.C. 102(a) as being unpatentable over Krause U.S. Patent no. 5,526,520 in view of Rivette et al. U.S. Patent no. 5,845,301."

Neither reference contains key elements of the claims

As noted and described in the discussion above regarding the rejection of claims 1 and 18-19 as being anticipated by Krause, Applicant has reviewed the Krause reference and is unable to find any description or even suggestion of the elements of Applicant's claims. In particular the elements of Applicant's claims include quoted passages and the highlighting of such quoted passages.

Rivette does not supply those elements missing from Krause. By the Examiner's own admission, Rivette discloses a "searching mechanism" and a means to "display text and image documents in both synchronized and unsynchronized fashion."

Again, the Examiner has not presented a prima facie case of unpatentability for any claim. Instead, he has simply repeated the elements of the claims and asserted that they are all contained in the combination of the two cited references. The Examiner provides no evidence of where those claim elements can be found in the cited references, other than a broad range of pages and figures, nor can he, because any disclosure of the claimed invention is simply not in the two cited references, no matter how the Examiner attempts to combine them

The Examiner has provided no motivation for combining the references

Nor has the Examiner provided any motivation for the combining of the Krause and Rivette references, other than the searching element of claims 4-18 is not present in the Krause reference. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Since the "prior art" cited by the Examiner, even when combined, does not disclose key elements of each claim, Applicant is entitled to a patent on the invention as claimed and respectfully request that the Examiner withdraw his rejection and allow all pending claims.

Conclusion

The Examiner has provided information concerning communication and/or inquiries concerning this case. Applicant appreciates the Examiner's willingness to communicate and assist on this case and believes no response to this paragraph is necessary.

As previously noted, Applicant believes that the Examiner has not presented a prima facie case of unpatentability for any of the pending claims. Applicant has pointed out in the discussion of this action a number of elements that are neither described nor

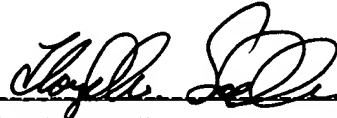
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AMENDMENT AND RESPONSE
TO NON-FINAL OFFICE ACTION

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Group Art Unit: 2171

even suggested by the cited references. Applicant believes that all issues and points of the Examiner's Office action have been addressed. Applicant believes that claims 1-20 are patentable over all known prior art. Applicant respectfully requests reconsideration and allowance of this application.

Respectfully submitted this 30th day of August, 2004.



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